

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper No. 1

Filed by: Michael P. Tierney
Administrative Patent Judge
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Filed
March 28, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

APPLIED RESEARCH SYSTEMS ARS HOLDING, N.V.

Junior Party,¹
(U.S. Patent No. 5,272,071),

v.

CELL GENESYS, INC.

Junior Party,
(Application 08/102,390).

Patent Interference No. 105,114 (MPT)

NOTICE REDECLARING INTERFERENCE NO. 103,737

Interference No. 103,737 was declared on March 22, 1996 between Chappel, U.S. Patent No. 5,272,071 ("071") and Skoultchi, U.S. Application No. 08/102,390 ("390"). (Interference No. 103,737, Notice Declaring Interference, Paper No. 1). Applied Research Systems ARS Holding, N.V. ("ARS"), which is a subsidiary of Ares-Serono S.A., is the real party in interest in

¹Due to the dispute over the scope of the counts and the priority benefit dates, both parties have been accorded junior party status. Senior party status shall be awarded prior to entering the priority phase of the interference.

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Chappel '071. (Interference No. 103,737, Paper No. 80). Cell Genesys, Inc. ("Genesys") is the real party in interest for Skoultchi '390. (Interference No. 103,737, Paper No. 77).

As set forth in Paper No. 87 of Interference No. 103,737, this interference is being completely redeclared to implement Trial Section procedures from the outset and allow the parties the opportunity to fully and fairly brief the issues of concern and file the necessary evidence in support of their allegations.

Parties are Not Precluded from Requesting Additional Counts

In declaring the interference, the APJ notes that the parties submitted proposed counts. Genesys proposed two counts whereas ARS proposed eight. (Interference No. 103,737, Paper Nos. 84 and 86). The Administrative Patent Judge ("APJ") has reviewed the record and determined that there is insufficient evidence at this time to demonstrate that the parties are claiming more than one separately patentable invention. Accordingly the APJ has declared this interference with a single count. Nothing in this Notice precludes a party from requesting authorization to file motion(s) under 37 C.F.R. § 1.633(c)(1) to add or substitute a count.

Authorization for Genesys Expedited Motion

ARS has argued that Genesys lacks written descriptive support for at least six of ARS's alleged independent and distinct inventions. (Interference No. 103,737, Paper No. 86). To help focus the issues presented in this interference, the APJ invites Genesys to file an expedited motion under 37 C.F.R. § 1.633(c)(2) to amend or add additional claims that would correspond

to ARS's allegedly distinct inventions. The expedited motion is due by no later than **April 9, 2003**.

Genesys currently has two pending claims in its involved application. As ARS has identified eight allegedly separate inventions, Genesys is authorized to file an amendment wherein the total number of pending claims does not exceed eight (8). In filing the motion and amendment, Genesys shall identify the written descriptive support for the added and/or amended claims. Genesys is authorized to file a side-by-side column form claim chart depicting the written descriptive support for its claims.

A moving party bears the burden of demonstrating that it is entitled to the relief requested. 37 C.F.R. § 1.637(a). A preliminary motion seeking to add or amend claims must, among other things, "show the patentability to the applicant for each claim proposed to be added or amended." 37 C.F.R. § 1.637(c)(2)(iii). To show patentability means that a party must establish that a claim proposed to be designated as corresponding to a proposed count complies with the written description requirement of the first paragraph of 35 U.S.C. § 112. Notice of the Chief Administrative Patent Judge of Nov. 6, 1998, "Interference Practice -- Interference Rules Which Require a Party to 'Show the Patentability' of a Claim," 1217 Off. Gaz. Pat. & Tm. Office 17 (Dec. 1, 1998).

ARS is not authorized to file an opposition to Genesys's expedited motion. As such, the expedited amendment to Genesys's claims may be granted prior to a review of whether Genesys met its burden of proof for "showing" the patentability of its added or amended claims under rule 37 C.F.R. § 1.637(c)(2)(iii). Accordingly, to ensure that ARS's rights are not prejudiced by the

expedited filing and entry of Genesys's amendment, for the duration of the interference Genesys shall bear the burden of proof with respect to compliance with the written description requirement for the claims that are added or amended in the expedited motion.

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

Part B. Judge designated to handle the interference

Administrative Patent Judge Michael P. Tierney has been designated to handle the interference. 37 C.F.R. § 1.610(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for taking action in the interference is scheduled for 11:00 a.m., May 7, 2003 (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party ("ARS")

Named inventor: Scott C. Chappel, Jamaica Plain, MA

Patent: U.S. Patent No. 5,272,071, issued December 21, 1993,
based upon U.S. Application No. 07/893,447,
filed May 28, 1992

Title: Method for the Modification of the Expression
Characteristics of an Endogenous Gene of a Given Cell Line

Assignee: Applied Research Systems Ars Holding, N.V., which is a
subsidiary of Ares-Serono S.A.

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Junior Party ("GENESYS")

Named inventors: Arthur I. Skoultchi, Larchmont, N.Y.

Application: U.S. Application No. 08/102,390, filed August 5, 1993

Title: Production of Proteins Using Homologous Recombination

Assignee: Cell Genesys, Inc.

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 1

A method according to claim 2 or claim 3 of ARS's U.S. Patent No. 5,272,071.

The claims of the parties are:

ARS's U.S. Patent No. 5,272,071:	1-58
Cell Genesys's U.S. Application No. 08/102,390:	105-106

The claims of the parties that correspond to Count 1 are:

ARS's U.S. Patent No. 5,272,071:	1-58
Cell Genesys's U.S. Application No. 08/102,390:	105-106

The claims of the parties that **do not** correspond to Count 1 are:

ARS's U.S. Patent No. 5,272,071:	None
Cell Genesys's U.S. Application No. 08/102,390:	None

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper ____²

Filed on behalf of [name of party]
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

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APPLIED RESEARCH SYSTEMS ARS HOLDING, N.V.

Junior Party,
(U.S. Patent No. 5,272,071),

v.

CELL GENESYS, INC.

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(Application 08/102,390).

Patent Interference No. 105,114 (MPT)

TITLE OF PAPER

² Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

- i. § 7: date for identifying lead and backup counsel.
- ii. § 8: date for identifying any real party in interest.
- iii. § 9: date for requesting copies of involved and benefit applications and patents.
- iv. § 17: date for filing list of proposed preliminary motions.
- v. § 19: date for accomplishing certain discovery.
- vi. § 20: date for filing clean copy of claims.
- vii. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
- viii. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
- ix. § 33: date for objecting to admissibility of evidence.
- x. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
- xi. § 35: dates when cross-examination can take place.
- xii. § 45: dates for taking action with respect to settlement discussions

Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference No. 105,114

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____

Part J. Signature of administrative patent judge


MICHAEL P. TIERNEY
Administrative Patent Judge

Date: 3-28-03
Arlington, VA

Enc:³

Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference.

³No Rule 690(b) or Form PTO-850 is enclosed.

cc (via Federal Express):

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